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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/043,325 | 01/14/2002 | Young-Won Song | HI-0070 | 6678 |
| 34610 | 7590 | 09/07/2006 | EXAMINER | |
| FLESHNER & KIM, LLP P.O. BOX 221200 CHANTILLY, VA 20153 | | | BHATIA, AJAY M | |
| | | ART UNIT | PAPER NUMBER | |
| | | 2145 | | |

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|----------------------------|------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/043,325 | SONG ET AL. | |
| | Examiner Ajay M. Bhatia | Art Unit 2145 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 July 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 24-26 and 28-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 24-26 and 28-41 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Examiner will respond to applicant arguments in the order that he submitted his remarks. After reviewing applicant's response it appears there may be some confusion with the application of MPEG-21 specification as prior art. On page 12, of applicant remarks applicant states "there is no standard model or representation for a Digital Item" examiner agrees this assertion. But applicant has not claimed a "standard model or representation for a Digital Item" specifically claim 41. Claim 41 discloses a data structure, which also does not have a standard model or representation. In reviewing traversal of the Double Patenting Rejection applicant fails to provide sufficient distinction that application 10/102,895 does not disclose the same invention.

In response to applicant arguments addressing the 102(f), it appears that applicant agrees with the examiner that the other inventors are disclosed in the prior art document, therefore examiner is unclear why they are not listed as inventors for the present application. Therefore the 102(f) rejection is not overcome.

Examiner has addressed applicant's argument towards a standard model. Data structures generally do not have standard model. Additionally the present claim limitations are not limited to what applicant has disclosed in the claim. Applicant discloses "comprising" in the preamble of the claim, allowing for additional content beyond what is disclosed in the claim limitations. Therefore examiner is not persuaded the present rejection remains.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 24-26, and 28-41 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of copending Application No. 10/102,895. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose the same Digital Item.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

Claims 24-26, and 28-41 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. At present multiple documents retrieved from ISO standard list additional inventors that are not listed in the current application.

Claims 24-26, and 28-41 are rejected under 35 U.S.C. 102(b) as being anticipated by (MPEG-21) Part1 (ISO/IEC JTC1/SC29/WG11 N 3500). (Date 2000-09-03) (Please note the date provided is more than 1 year prior to the filing in the United States)

For claim 24, (MPEG-21) teaches, a method of generating Digital Items for electronic commerce activities of multimedia data embodied in a computer-readable medium, comprising:

selecting a resource for electronic commerce activates of multimedia data;
((MPEG-21), page iix)
generating for the resource an atomic Digital Item for the resource which is not further divided and a packaged Digital Item, wherein the packaged Digital Item is defined to include any sub packaged Digital Item in a recurrent package form in which

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the atomic Digital Item is packaged or already package Digital Item are again packaged, therefore each packaged Digital Item is generated in a recurrent manner; ((MPEG-21), page ix)

wherein in order to construct the recurrent layered structure of the Digital Items, the atomic Digital Item as a lowest layer is defined as component, the packaged Digital Item as a middle layer is defined as item, and /or packaged Digital Items as a highest layer is the defined as container; ((MPEG-21), page ix)

and generating the component, the component is defined to include the selected resource, an anchor for designating the selected resource, optionally a descriptor for describing details of the resource, and optionally an opCondition for describing operational use conditions of the resource, ((MPEG-21), pages 12-32 and 41-43)

wherein the packaged Digital Item is defined to include an anchor for designating the same level of Digital Item or an anchor for designating lower a level of Digital Item, such that in of generating the item, the item is defined to include packaged content including at least one component or item or anchor, and optionally a choice for the packaged content; ((MPEG-21), pages 12-32 and 41-43)

and optionally a descriptor for describing details of the packaged content; ((MPEG-21), pages 12-32 and 41-43)

and/or in of generating the container, the container is defined to include packaged content including at least one item or container or anchor, and optionally a

descriptor for describing details of the packaged content. ((MPEG-21), pages 12-32 and 41-43)

For claim 25, (MPEG-21) teaches, the method according to claim 24, wherein the anchor used for all Digital Items is denied to include a reference being a identifier designating uniquely a Digital Item, at least zero or more descriptor for describing the anchor, and at least zero or more opCondition for describing a usage format of the anchor. ((MPEG-21), pages 12-32 and 41-43)

For claim 26, (MPEG-21) teaches, the method according to claim 25, wherein opCondition used for anchor defines operational use conditions for corresponding item by use of at least one or more predicate which is Boolean function.

For claim 28, (MPEG-21) teaches, the method according to claim 24, wherein generating the component is defined to include selectively a murCondition for describing condition related to management and use rule for the resource, an eventReport for describing an event to be reported in connection with the resource, a userPreference for describing user preference information on the resource, or a reservedMetadata for describing metadata additionally required for a future Digital Item definition model. ((MPEG-21), pages 12-32 and 41-43)

For claim 29, (MPEG-21) teaches, the method according to claim 28, wherein the UserPreference is defined to include an anchor for designating existing user preference information, a descriptor for describing content of the user preference information, and murCondition capable of describing a management and use rule of the user preference information. ((MPEG-21), pages 12-32 and 41-43)

For claim 30, (MPEG-21) teaches, the method according to claim 28, wherein the murCondition used for all the Digital Items, eventReport, userPreference, and reservedMetadata defines conditions for a management and use rule of a corresponding Digital Item or definition model elements by use rule of corresponding Digital Item or definition model elements by use of at least one or more predicate which is Boolean function representation language. ((MPEG-21), pages 12-32 and 41-43)

For claim 31, (MPEG-21) teaches, the method according to claim 29, wherein the opCondition describes conditions, including at least one transmission bit rate, resolution or video or image, sampling rate of audio, compression algorithm, key or decoding conditions if coded and transmission protocol. ((MPEG-21), pages 12-32 and 41-43)

For claim 32, (MPEG-21) teaches, the method according to claim 24, wherein generating the item is defined to include selectively a murCondition for describing conditions related to a management and use rule for the packaged content, an eventReport for describing an event to be reported in connection with the packaged

content, a userPreference for describing user preference information on the packaged content, or a reservedMetadata for describing metadata additionally required for a future Digital Item definition model. ((MPEG-21), pages 12-32 and 41-43)

For claim 33, (MPEG-21) teaches, the method according to claim 32, wherein the eventReport is defined to include an anchor for designating a server computer for processing, managing and storing content of a reportable event report, a descriptor for describing the content of the event report, and a murCondition for describing conditions related to a management and use rule of the event report content. ((MPEG-21), pages 12-32 and 41-43)

For claim 34, (MPEG-21) teaches, the method according to claim 24, wherein generating the container is defined to include selectively a murCondition for describing condition related to a management and use rule of the packaged content, an eventReport for describing an event to be reported in connection with the packaged content, an userPrefernce for describing user preference information on the packaged content, or a reservedMetadata for describing metadata additionally required for a future Digital Item definition model. ((MPEG-21), pages 12-32 and 41-43)

For claim 35, (MPEG-21) teaches, the method according to claim 24, wherein the choice is defined to include a recurrent form of at leas zero or more choice, at least zero or more descriptor, at least zero or more opCondition that can be used to determine

whether a single selection is selected or more than one selection are selected, and at least one or more selection as the object of selection. ((MPEG-21), pages 12-32 and 41-43)

For claim 36, (MPEG-21) teaches, the method according to claim 35, wherein the selection is defined to include predicate which is Boolean function representation language, at least zero or more descriptor for describing the content of the selection, and opCondition for describing operational use condition of the selection, as elements included to define the choice. ((MPEG-21), pages 12-32 and 41-43)

For claim 37, (MPEG-21) teaches, the method according to claim 24, wherein the choice is used for item level for the purpose of selective item configuration in order to adapt the Digital Item according to the various types of network and terminals, or the user request, and wherein the choice is modeled in a recurrent form considering the user generally configures item through multi-step, so layered definition of choice is required. ((MPEG-21), pages 12-32 and 41-43)

For claim 38, (MPEG-21) teaches, the method according to claim 24, wherein a descriptor used for all the Digital Items, choice, selection, eventReport, userPreference, reservedMetadata, and anchor, is defined to include at least zero or more existing descriptors or anchor, a component capable of representing the content of the descriptor or statement of text or any machine readable format for describing the

content including parent element of the descriptor to be defined, and at least zero or more opCondition of describing operation conditions of descriptor. ((MPEG-21), pages 12-32 and 41-43)

For claim 39, (MPEG-21) teaches, the method according to claim 24, wherein the anchor used for all Digital Item, eventReport, userPreference, reservedMetadata, and descriptor, is defined to include a reference being and identifier designating a uniquely atomic Digital Item and each Digital Item at, least zero, or more descriptor for describing the anchor, an at least zero or more opCondition for describing usage format of the anchor. ((MPEG-21), pages 12-32 and 41-43)

For claim 40, (MPEG-21) teaches, the method according to claim 24, wherein the opCondition used for a Digital Item of the component level, descriptor, anchor, choice, and selection defines operational use conditions for corresponding item or definition model elements by use of at least one ore more predicate which is Boolean function representation language. ((MPEG-21), pages 12-32)

For claim 41, (MPEG-21) teaches, the method of according to claim 24, wherein container item and component are generated as Digital Item in order to provide a selected resource as the unit of manipulation for electronic commerce activites accordin to the following element definitions:

(a)container::=(anchor.vertline.container)* (anchor.vertline.item)*
descriptor* murCondition* eventReport* userPreference* reservedMetadata*
(b)item::=(anchor.vertline.item.vertline.component)+choice* descriptor* murCondition*
eventReport* userPreference* reservedMetadata* (c)component::=resource anchor
descriptor* murCondition* opCondition* eventReport* userPreference*
reservedMetadata* (d) anchor::=reference descriptor* opCondition* (e)
descriptor::=(anchor.vertline.descriptor)* (component.vertline.statement) opCondition*
(f) choice::=choice* selection+descriptor* opCondition* (g) selection::=predicate
descriptor* opCondition* (h) eventReport::=anchor descriptor murCondition (i)
userPreference::=anchor descriptor murCondition (j) reservedMetadata::=anchor
descriptor murCondition (k) murCondition::=predicate+(l) opCondition::=predicate+
((MPEG-21), pages 12-32)

wherein '*' means at least zero(0) or more, '+' means at least one(1) or more,
and '.vertline.' means 'OR' logical operation. ((MPEG-21), pages 12-32)

Conclusion

The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure. See attached Notice of references cited (if appropriate).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time
policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay M. Bhatia whose telephone number is (571)-272-3906. The examiner can normally be reached on M-F 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Cardone
Supervisor Patent Examiner
Art Unit 2145

AB